

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. Rejection of claims 24-36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 2,559,261 (*Schwartz*) in view of U.S. patent 3,641,730 (*Meckstroth*), U.S. patent 3,350,827 (*Sugar*), U.S. patent 6,863,768 (*Haffner*) and U.S. patent 4,479,333 (*Hendrich*)

Reconsideration of this rejection is respectfully requested in view of the remarks submitted in the reply dated September 26, 2008 (repeated substantially herebelow), and the following additional observations.

Independent claim 24 requires that the packaged set of floor panels include “at least two types of individual floor panels” having different lengths which are “configured to form together at least part of one and a same floor covering.” The claims also require that these separately sized floor panels have coupling parts which “cooperate with one another for forming the floor covering.”

In the current rejection of the claims which includes new grounds for rejecting the claims, the teachings of *Schwartz* are relied upon to show how it was known to provide a set of floor panels configured for forming one and a same floor covering in a package, a limitation of which is required by the pending claims. The Applicant respectfully disagrees that *Schwartz* teaches such limitations.

As a precursor, it should be made readily apparent that *Schwartz* does not describe actual floor panels for walking upon but instead describes an architectural model which includes representative floor panels for use in simulating a floor in the model. The floor panels are intended to simulate different sized floors of an actual building (i.e., 8 feet by 16 feet, or 16 feet by 16 feet), but are distinguishable from floor panels which form a floor covering which cover an existing floor.

There is no understanding available to the skilled person as to how these components of the architectural model of *Schwartz* can be converted to normal construction building elements taught by *Meckstroth*, *Haffner*, *Hendrich* and *Sugar*.

Schwartz confesses that there is no structural framework to the architectural model (3:52-53), and as such, the skilled person would neither understand to apply nor rely upon the teachings of *Schwartz* in actual building construction materials of the type taught by *Meckstroth*, *Haffner*, *Hendrich* and *Sugar*.

In observing Fig. 1, *Schwartz* explains that the floor panels (50, 51, 52) are simply rectangular boards, sheets or panels which are laid flat upon horizontally extending portions of wall portions (23b – see Fig. 13) (5:42-47). The floor panels of *Schwartz* form the actual floor of the model, and do not form a “floor covering” which is required of the set of packaged floor panels of the pending claims.

Next, while the floor panels of *Schwartz* form part of a larger architectural construction set, there is no teaching that the floor panels are packaged in a single box, as required by pending claim 24. Indeed, there is no description as to how any of the components of the model are packaged.

The rejection indicates that *Schwartz* teaches that the floor panels are strip shaped, however in observing Fig. 1 and the description of the floor panels in the specification (3:42-73), it is clear that the floor panels are formed quite contrary to a strip shaped form. They instead form the entirety or near entirety of the floor of a room in the architectural model.

The skilled person would understand the term “strip,” whether from its ordinary meaning or the description in the pending application (e.g., Figs. 1, 4 and 5), as a long, narrow piece. At best, *Schwartz* teaches that the width of a floor panel is half of the length (i.e., 8 feet versus 16 ft). Thus, while the floor panel according to *Schwartz* is long, it is hardly narrow compared to the length of the floor panel and is therefore not “strip shaped.”

Lastly with regard to *Schwartz*, it is clear that the floor panels of *Schwartz* are devoid of any mechanical coupling parts. In fact, *Schwartz* teaches the contrary. *Schwartz* specifies that the floor panel is merely laid flat upon horizontally extending portions of the wall panels (3:42-45) and essentially float relative to one another. Moreover, Fig. 1 of *Schwartz* does not illustrate any coupling parts on any of the four

edges of the floor panel (50), further reinforcing the teaching of *Schwartz* that the architectural model has no structural framework.

Therefore, in contradistinction to the allegation in the Office Action, there are no coupling parts in the floor panels of *Schwartz*, and indeed the skilled person would be deterred from providing any coupling parts on the floor panels of *Schwartz* since the floor panels essentially float relative to one another.

In view of these observations, it is at least submitted that *Schwartz* does not disclose many of features which are attributed to *Schwartz* in the rejection.

Taking these observations on the shortcomings of *Schwartz* in mind, in the following it is explained how *Meckstroth*, *Haffner*, *Hendrich* and *Sugar* fail to make up for the shortcomings of *Schwartz* and consequently how the combination of *Schwartz*, *Meckstroth*, *Haffner*, *Hendrich* and *Sugar* fail to disclose or suggest the set of packaged floor panels according to the pending claims.

Before proceeding, however, it will be pointed out that while the Applicant addresses each of the prior art documents in the rejection individually in light of the asserted combination of references, the Applicant is arguing that the asserted combination of these references cannot be used to reject the pending claims because the rejection fails to make out a *prima facie* showing of obviousness.

In short, it is submitted that there cannot be any teaching or suggestion in the prior art, or understanding available to the skilled person to pull together the specific features of the different references as argued in the rejection, among other things, because there was no appreciation in the cited prior art that the existing solution of the set of packaged floor panels was inadequate in any way, or that a new combination was needed.

The Applicant's previous remarks pointed out the shortcomings of *Meckstroth*, *Haffner*, *Hendrich* and *Sugar*. However, because new grounds for rejecting the claims were established, the rejection did not particularly address the previously-submitted shortcomings of these prior art documents.

Accordingly, the Applicant hereby resubmits these arguments because they are considered relevant and still pertinent in view of the new grounds for rejecting the

claims, and kindly requests the Examiner's reasons for maintaining the rejection in view of these observations pointing out how the combination of *Schwartz*, *Meckstroth*, *Haffner*, *Sugar* and *Hendrich* fails to describe the set of packaged floor panels of the pending claims.

Turning to *Meckstroth*, this prior art document teaches that the structural panels may be provided in different widths or lengths. However, there is no suggestion by *Meckstroth* of taking the unobvious step of the pending claims to provide a set of floor panels having different lengths in a single box, as required by the pending claims. Instead, *Meckstroth* merely indicates that the panels may be prefabricated in different widths or lengths (2:50-55). It has therefore been submitted that there is no indication that these differently sized panels in *Meckstroth* may be provided in a set for forming one and the same floor covering.

The limitations of claim 24 inherently require that these differently sized first and second types of floor panels have coupling parts which couple with one another so as to form the one and same floor covering. *Meckstroth* teaches differently sized panels but the rejection does not show or suggest how these panels combine with one another to form a one and single floor covering and are packaged in a set together in a single box, as currently recited in claim 24.

In observing *Meckstroth*, it is readily apparent that the passage relied upon in the rejection (2:50-55) simply conveys that panels of different dimensions may be produced according to different applications such as "depending on whether the panels are intended for use as floor panels, wall panels, ceiling panels, or roof panels." From this passage, without the benefit of the pending application, one skilled in the art would understand that depending on the particular application, the structural panels will have a certain dimension. For example, the structural roof panels may have a certain width and length, whereas the structural floor panels may have a certain width that is different from the roof panels.

Extending the reasoning of the Action, the rejection appears to assert that a manufacturer of the panels of *Meckstroth* would package these differently sized panels together despite the fact that their dimensions are particularly tailored for

different applications. Thus, the skilled carpenter would receive a package of panels having 2 feet, 4 feet, 6 feet, etc., which are suited for use in different applications such as floor panels, wall panels, ceiling panels. Because the panels are in different sizes, the skilled carpenter building a roof would likely be left with an assortment of panels of *Meckstroth* which are too small (i.e., 2 feet) or too large (i.e., 6 feet) for the particular application, and quickly run out of panels (i.e., 4 feet) hypothetically best suited for the roof.

Therefore, the skilled person would not readily recognize from *Meckstroth* the inventive step of packaging a plurality of different types of floor panels for forming part of one and the same floor covering in a single box.

Claim 24 clearly requires that the differently sized panels be provided in a set for forming one and the same flooring covering, and that the set of panels is packaged in a single box. It is submitted that *Meckstroth* clearly does not advise the skilled artisan of doing anything more than merely providing differently sized structural panels, and does not motivate the skilled artisan to take the unobvious step of packaging the set of panels in a single box, as mandated by the pending claims.

Further, it appears in the Action that the rejection relies on the assumption that the differently sized panels of *Meckstroth* are necessarily provided together in a single package and arranged to couple with one another for the same application. The Applicant respectfully disagrees. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). (Also cited in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007)).

The Applicant finds no articulated reasoning to modify the differently sized structural panels of *Meckstroth* to form one and the same floor covering while being packaged together in a single box. Indeed, as pointed out above, the panels of *Meckstroth* are provided in different widths and lengths depending on their defined application. One of ordinary skill in the art would not reasonably consider the

differently sized panels of *Meckstroth* as consisting of or relating to a packaged set in a box arranged to form one and a same floor covering.

Claim 24 requires that the first and second types of floor panels have different decors which are formed by decorative paper soaked in resin. As depicted in Figs. 5 and 6 of the specification, this limitation indicates that the first and second types of floor panels will have a decor different from one another, which are at least due in part to the fact that they have different lengths.

The Action provides no evidence of a set of floor panels having first and second types with different decors. Indeed, the Action readily acknowledges that the outer skin of the panel in *Meckstroth* is plywood, and is obviously not of a decorative paper layer soaked in resin.

As for *Sugar*, this reference likewise fails to disclose or suggest a set of floor panels having first and second types of different decors formed from a decorative paper layer. Instead, the decors are formed by artificial stone or the like (1:9-12).

Haffner, which is relied upon in the Action for its decorative layer, does not convey the understanding to the skilled person to provide first and second types of floor panels having both different lengths and different decors.

Taking the teachings of *Sugar* and *Haffner* together, there is no evidence that the skilled person would understand from *Sugar* to configure the decorative layers in *Haffner* with different decors.

Hendrich, which is relied upon in the Action for the teaching of packaging panels for transportation, does not suggest to the skilled person the concept of floor panels of different lengths being packaged in a single box. Contrary to the assertion in the Action that the skilled person would have appreciated packaging panels in “any convenient, efficient and low cost manner,” it is submitted that the skilled person would not understand packaging panels in a single box from *Hendrich* because *Hendrich* describes large-scale, interconnected (via hinged joints) structural panels which are particularly used as building modules (i.e., floor panels – not a floor covering, side wall panels, and roof elements).

The panels of *Hendrich* are of a magnitude that the skilled person would readily recognize as being unsuited for packaging in a single box. Particularly, at least in reference to claim 35, the skilled person would not understand from *Hendrich* to provide floor panels having different lengths in that a first type of floor panel having a first length spans the length of the box, and the second and third type of floor panels (of different lengths) are arranged in the box at the same level and have second and third lengths which combine to span the entire length of the box (i.e., combined length the same as the first length).

With regard to dependent claim 33, the Applicant respectfully disagrees that it is mere design choice to establish the ratio of length relative to the width of the floor panel. In fact, it is one of the objectives of the invention to provide a technical means which allows for the minimization of an unnatural appearance of laminate flooring in one and the same floor covering. The specific length-to-width ratio recited in claim 33 provides a technical solution to allow for the minimization of the unnatural appearance so as to provide a laminate floor covering having a better plank-like floor appearance.

The particular limitations of claim 24 and the combination thereof with the length-to-width ratio of claim 33 greatly contribute to a plank-like appearance of the claimed set of floor panels. For example, claim 24 particularly recites that the panels have different lengths, which in turn due to the different lengths, the joints at the short edges do not repeat at regular distances and an unnatural regular staggering pattern is avoid. In another example, claim 24 recites that the panels of different lengths are packaged in one box, which automatically provides a good mix of panels of varying lengths that can be used together to form a floor covering that more closely simulates a real, plank-like floor appearance.

In the view of these observations, it is submitted that the proposed combination of *Schwartz*, *Meckstroth*, *Haffner*, *Hendrich* and *Sugar* fails to render the pending claims *prima facie* obvious since these references taken as a whole and in combination fail to teach every feature required by the pending claims. Moreover, there is no suggestion among these references or rationale articulated in the rejection which shows that one skilled in the art would be motivated to make the proposed

combination to devise the set of packaged decorative floor panels according to the pending claims.

Accordingly, withdrawal of the rejection is respectfully requested.

2. Rejection of claim 35 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 2,559,261 (*Schwartz*) in view of U.S. patent 3,641,730 (*Meckstroth*) in view of U.S. patent 6,863,768 (*Haffner*), and U.S. patent 4,479,333 (*Hendrich*) and further in view of U.S. patent 5,403,055 (*Allison*)

Reconsideration of this rejection is respectfully requested in view of the requirements of claims 24 and 35 which describe the set of floor panels as being "packaged," and the preceding remarks on the rejection based on the combination of *Schwartz*, *Meckstroth*, *Haffner* and *Hendrich* of claim 24 from which claim 35 depends, and the following observations on *Allison*.

In the Action, *Allison* is relied upon to show that it was known to arrange building panels at a same vertical level in a package so as to span the entire length of the package. However, it will be noted that claim 35 requires more than such a proposition, as articulated in the Action. Instead, claim 35 particularly requires that a panel of a first type of panel spans the length of a box, and that a floor panel of each a second and third type of panels, which are described as having different lengths, are arranged in the box at a same level so as to combine to span the entire length of the box.

Nowhere in *Allison* is there any particular understanding of a packaged set of panels packaged in the manner required by claim 35. Indeed, while the Action refers to Figs. 4, 6 and 7 of *Allison* as teaching the basic limitations of claim 35, these figures appear to only describe panels, logs and roof trusses of a single length, and not those of multiple lengths. Because the panels, logs and roof trusses described by *Allison* are of a single length, there is no specific understanding or even a suggestion of arranging panels of different second and third lengths along a same level in a box.

Thus, *Allison* fails to disclose or suggest every limitation for which it is included in the combination with *Schwartz*, *Meckstroth*, *Haffner* and *Hendrich*.

Likewise, *Schwartz, Meckstroth, Haffner* and *Hendrich* fail to make up for the shortcomings of *Allison*.

Accordingly, the skilled person would not understand from the combination of *Schwartz, Meckstroth, Haffner, Hendrich* and *Allison* the limitations of claim 35. Further, there is no evidence or rationale articulated on the record which shows that it was known to arrange panels of different second and third lengths along a same level in a box.

Withdrawal of this rejection is respectfully requested.

3. Conclusion

In view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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